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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,210	09/25/2003	Katsuhisa Yamaguchi	0905-0292P	2143

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EXAMINER
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SIKRI, ANISH

ART UNIT	PAPER NUMBER
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2143

NOTIFICATION DATE	DELIVERY MODE
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07/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/669,210

Applicant(s)

YAMAGUCHI ET AL.

Examiner

ANISH SIKRI

Art Unit

2143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/21/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claim 7 is cancelled

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brickell et al (US Pub 2003/0115142) in view of Mighdoll et al (US Pat 6,073,168).

Consider Claim 1, Brickell et al discloses digital service system comprising a client computer, a service server and a center server, wherein said service server includes a first transmitting device for sending said center server data indicating content of a service implemented in said service server (Brickell et al, Fig 1, 4, [0018]),. The Client Computer is being treated as a user 102, 402 stated in Brickell et al (Fig 1, Fig 4, [0006]). Service center is treated as authentication server 106, 408 stated in Brickell et al (Fig 1, Fig 4, [0018]). The center server is being treated as Relaying Party 104, 404 (Fig 1, Fig 4, [0018]).

But Brickell et al does not explicitly state said client computer includes a second transmitting device for sending said center server a service-list request command; and said center server includes: a storage control device for storing the service-content data, service authorization-level data and address data, which has been transmitted from said first transmitting device of said service server, in a management table; a service-list generating device for generating a service list, which includes service content and network address of said service server, from the data that has been stored in the management table, based upon the service authorization level in response to the service-list request command transmitted from said second transmitting device of said

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client computer; and a third transmitting device for sending said client computer data indicating the service list that been generated by said service-list generating device.

Nonetheless, Mighdoll et al disclosed said client computer includes a second transmitting device for sending said center server a service-list request command (Mighdoll et al, Col 14 Lines 58-68); and said center server includes: a storage control device for storing the service-content data (Mighdoll et al, Col 4 Lines 60), service authorization-level data and address data (Mighdoll et al, Col 15 Lines 1-12), which has been transmitted from said first transmitting device of said service server (Mighdoll et al, Col 14 Lines 58-68), in a management table (Mighdoll et al, Col 14 Lines 28-30 Lines 58-68); a service-list generating device for generating a service list (Mighdoll et al, Col 14 Lines 58-68, Col 15 Lines 1-12), which includes service content and network address of said service server (Mighdoll et al, Col 15 Lines 1-12, 46-53), from the data that has been stored in the management table (Mighdoll et al, Col 14 Lines 28-30 Lines 58-68), based upon the service authorization level in response to the service-list request command transmitted from said second transmitting device of said client computer (Mighdoll et al, Col 14 Lines 58-68); and a third transmitting device for sending said client computer data indicating the service list that been generated by said service-list generating device (Mighdoll et al, Col 14 Lines 58-68). Mighdoll et al's invention clearly shows on the use of server-generated list (ticket), which is requested by the client (Mighdoll et al, Col 14 Lines 58-68). The Management table is being considered as a user database (Mighdoll et al, Col 14 Lines 28-30 Lines 58-68).

Mighdoll et al disclosed that the service list does include the network address of the server (Mighdoll et al, Col 15, Lines 45-53)

Both Brickell et al and Mighdoll et al provide features related to communication in the network between clients and servers. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

Therefore, it would be obvious to a person of ordinary skill in the art at the time of the invention was made to implement the use of system generated service list from the server which is to be transmitted to the client's request, taught by Brickell et al, for the purpose of utilizing a peer-to-peer network system in which a user is provided with a service.

Consider Claim 2, and as applied to claim 1 above, Brickell-Mighdoll et al disclosed that the client computer further includes a fourth transmitting device for transmitting a service request to a service server having an address contained in a service list (Mighdoll et al, Col 15 Lines 1-12, Col 16 Lines 9-19) represented by service list data that has been transmitted from said third transmitting device of said center server (Mighdoll et al, Col 14 Lines 58-68, Col 15 Lines 1-12). Mighdoll et al clearly shows on how the service request "ticket" contains address and other relevant information for the client (Col 15 Lines 45-53).

Consider Claim 3, and as applied to claim 1 above, Brickell-Mighdoll et al as modified by Mighdoll et al disclosed the service server further includes: an authentication device for authenticating said client computer in response to a service request transmitted from said fourth transmitting device of said client computer (Brickell et al, Fig 3, Fig 4, [0036], [0057]); and a service execution device for executing processing (Brickell et al, Fig 3, Fig 4, [0036], [0071]), which is based upon the service request transmitted from said fourth transmitting device of said client computer, in response to authentication by said authentication device (Brickell et al, Fig 3, Fig 4, [0071]). Brickell et al clearly shows on how the server conducts authentication in a peer-to-peer network system when the client requests a service request.

Claim 4, it is has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

Claim 5, it is has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

Claim 6, it is has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

Consider Claim 8, Brickell-Mighdoll et al disclosed the digital service system of claim 1 wherein said network address further comprises an Internet Protocol (IP) address (Mighdoll et al, Col 15 Lines 45-53).

Claim 9, it is has similar limitations as Claim 8, therefore it is rejected under the same rational as Claim 8.

Claim 10, it is has similar limitations as Claim 8, therefore it is rejected under the same rational as Claim 8.

Claim 11, it is has similar limitations as Claim 8, therefore it is rejected under the same rational as Claim 8.

### ***Response to Arguments***

Applicant's arguments filed 8/17/2007 have been fully considered but they are not persuasive.

Client argues for Claim 1, 4, 5, 6, that combination of Brickell-Mighdoll et al does not teach the limitation "sending said client computer data indicating the service list", where the service list "includes service content and network address of said server".

In fact, Mighdoll et al does indeed teach the following limitation of service list containing network address of the server (Col 15 Lines 37-53), and further support can



be found in (Col 16, Lines 10-19). Mighdoll et al disclosed that the server sends the list to the clients, containing information relating to services offered, and the IP address of the services.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH SIKRI whose telephone number is 5712701783. The examiner can normally be reached on 8am - 5pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anish Sikri examiner 2143  
a.s.

June 8, 2008

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2154